

II. REMARKS

Claims 1, 3-11, 14-19, 21-32 and 34-36 are pending. Claims 25-30 have been withdrawn from consideration pursuant to a restriction requirement. Claims 2, 12, 13, 20 and 33 have been canceled. Thus, claims 1, 3-11, 14-19, 21-24, 31, 32 and 34-36 are pending and stand variously rejected under 35 U.S.C. §§ 102 and 103.

By amendment herein, claim 1 has been amended to specify that the vaso-occlusive member does not include retention devices such as stents and, in addition, to specify that if combinations of bioactive materials are used the multiple materials do not form multiple layers. Claims 4, 21 and 23 have been amended to write out all abbreviations. New claim 37 has been added, as described for example in original claim 1. These amendments are made solely to further prosecution and entry thereof is respectfully requested. Applicant reserves the right to file a continuation or divisional application directed to the subject matter of the original claims during the pendency of this application.

Applicant gratefully acknowledges withdrawal of the rejection of claims 34-35 under U.S.C. § 112, second paragraph.

In view of the foregoing amendments and following remarks, Applicant respectfully requests reconsideration of the application and withdrawal of the remaining rejections.

Objections

Claims 4, 21 and 23 were rejected for failing to spell out abbreviations. The claims have been amended as indicated above to obviate these objections.

Rejections Under 35 U.S.C. § 102

Claims 1, 3, 4, 5, 6, 7, 8, 11, 14, 16, 17, 18, 19, 21, 22, 23 and 24 stand variously rejected as allegedly anticipated by a variety of references. (Office Action, paragraphs 5-7). Applicant addresses the rejections in turn.

Rejections Based on Eder

Claims 1, 3, 4, 11, 14, 18, 19, 21 and 24 are rejected under § 102(b) as allegedly anticipated by U.S. Patent No. 5,980,550 (hereinafter "Eder"). Eder is cited for disclosing a vaso-occlusive coil, a thrombus-stabilizing molecule and a bioactive material in the form of cytokine VEGF. (Office Action, paragraph 11). In response to arguments that that Eder necessarily includes more components than the claimed devices, the Office states there is no limitation that places combinations of bioactive materials in the same layer. (See, page 7 of the Office Action).

In view of the foregoing amendment making it explicit that when combinations of bioactive materials are used, they do not form multiple layers, Applicant submits that Eder fails to anticipate any of the currently pending claims. Again, the claimed compositions and methods always include fewer elements than contained in Eder and, accordingly, this reference cannot anticipate any of the pending claims.

Rejections Based on Callister

Claims 1, 5, 6, 16, 19 and 22 are alleged to be anticipated under 102(e) by U.S. Patent No. 6,096,052 (hereinafter "Callister"). Callister is cited for teaching a device comprising a vaso occlusive member and copper. (Office Action, paragraph 6).

Because Callister's compositions also necessarily include a mesh layer not present in the compositions of claims 1, 5, 6, 15, 19 and 22, this reference fails to anticipate the pending claims and withdrawal of this rejection is requested.

Rejections Based on Schwartz

In addition, claims 1, 7, 8, 11, 17, 19 and 23 stand rejected as allegedly anticipated by U.S. Patent No. 5,800,507 (hereinafter "Schwartz"). (Office Action, paragraph 7).

Because the pending claims explicitly exclude stents (or retention devices), Schwartz cannot anticipate the pending claims. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

The Examiner has also maintained the rejection of claims 9 and 10 as allegedly obvious over Schwartz. (Office Action, paragraph 9). In addition, claim 15 remains rejected as allegedly obvious over Schwartz in view of U.S. Patent No. 5,891,192 (hereinafter "Murayama"). (Final Office Action, paragraph 10). Furthermore, claims 31, 32 and 35-36 are newly rejected as allegedly obvious over U.S. Patent No. 5,690,666 (hereinafter "Berenstein") in view of WO 00/27445 (hereinafter "Boock"). (Office Action, paragraph 11). Finally, claim 34 is rejected as allegedly obvious over Berenstein in view of Boock and in further view of Murayama.

Applicant addresses the rejections in turn.

With regard to the rejections based on Schwartz, Applicant submits, for the reasons detailed above, that this reference fails entirely to disclose a vaso-occlusive member that is a coil and/or a filter, as presently claimed. For its part, Murayama also fails to teach vaso-occlusive members as claimed. Therefore, Schwartz, alone or in combination with Murayama, cannot render pending claims 9, 10 and 15 obvious.

Turning to the rejections of claims 31, 32 and 35-36 over Berenstein in view of Boock and claim 34 over Berenstein in view of Boock and in further view of Murayama, Applicant submits that there is no motivation in any of these references to arrive at the compositions set forth in these claims.

It is impermissible to base an obviousness rejection on a combination of references, where none of the references suggest the combination. *See, e.g., In re Napier*, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995). Rather, the art must suggest the desirability of the modification. *See, e.g., In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Nor can the Office simply state that the general level of skill in the art was high and, accordingly, the motivation is present. *See, e.g., In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998); and *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002) (affirming that common knowledge and common sense are not the specialized knowledge and expertise necessary to establish a motivation to arrive at the claimed invention).

There is nothing in Berenstein, Boock and/or Murayama that suggests combining vaso-occlusive members, particulate liquid embolics and an additional bioactive agent (at least one cytokine; extracellular matrix material; DNA; RNA; functional fragments of DNA, RNA, cytokines or extracellular matrix material; and combinations thereof). The fact that each of the claimed elements were known separately (or even in different combinations), does not change the fact that they were not used in the combination as claimed or, more importantly, that the references suggest combining the elements as claimed. Since there is no motivation to combine the various teachings of Berenstein, Boock and Murayama as set forth by the Office, a *prima facie* case of obviousness cannot be sustained. Accordingly, Applicant requests that this rejection be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicant believes the claims are in condition for allowance and requests early notification to that effect. If the Examiner believes there are any outstanding issues, she is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

Date: 18 July 03

By: *Dahna S. Pasternak*
Dahna S. Pasternak
Registration No. 41,411

Robins & Pasternak LLP
1731 Embarcadero Road
Suite 230
Palo Alto, CA 94303
Tel.: (650) 493-3400; Fax: (650) 493-3440